

Claim 21 (new) - The method of claim 20 wherein said reorienting step includes selecting from a plurality of second outcomes such that said selected second outcome represents a maximum award when compared with alternative second outcomes.

Claim 22 (new) - A method of gaming, the steps including:

- enabling a gaming device;
- generating a first outcome;
- comparing said first outcome to a payable;
- awarding credits if said first outcome is present on said payable;
- manipulating said first outcome according to a rule set if and only if said first outcome is not present on said payable, and if and only if said second outcome is present on said payable; and
- awarding credits if said second outcome is present on said payable.

REMARKS

The Office Action dated May 16, 2002 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the specification and claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art and certain typographical inexactitudes have been rectified to provide better form. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

It is believed that the foregoing revisions to the claims are within the metes and bounds of the recently articulated Supreme Court *Festo* case, in that all equivalents

susceptible to capture have been retained in that one skilled in the art, at the time of this amendment, could not have reasonably be expected to have drafted a claim that would have literally encompassed any other equivalent.

Rejections under 35 U.S.C. § 102

With respect to rejections under 35 U.S.C. § 102, the Examiner is invited to consider the following binding, compelling precedent articulated by the Court of Appeals for the Federal Circuit:

“. . . anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference.” *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986).

Further, “those elements must either be inherent or disclosed expressly . . .” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987). “. . . and must be arranged as in the claim[s] . . .” *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986).

In addition, “. . . [the] absence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986).

The Examiner has rejected claims 1 through 16 under 35 U.S.C. § 102(b) as being anticipated by Bessho '169. Undersigned respectfully submits that the symbol-moving features of the instant invention are enabled only if the initial outcome is not recognized by the paytable. If the initial outcome is recognized by the paytable, the player is awarded and the game ends. If, and only if, the initial outcome is not present on the

paytable, then the visible symbols are compared to the paytable according to a rule set. Bessho's specific condition detecting circuit (47) is always active after the reels (5 to 9) stop moving (col. 3, lines 51-58), so the output is only checked against the paytable once. By contrast, an additional condition is present in the present invention. Claims 1, 7, 10, 11, 15, and 16 have been amended to make this distinction explicit, namely, that the output is first examined for its presence on the paytable, and if there is no match, another comparison takes place and the movable output features of the instant invention are engaged. If there is an initial match on the paytable, the player is awarded and the game ends.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

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Bracketed and Underlined Paragraph of Specification

13. These features may be applied to table card games. For example, cards can move from row to row to establish the best possible winners, or cards may change rank or suit to provide a winning [sinning] hand.



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Bracketed and Underlined Claims

Claim 1 (amended) - A gaming device, comprising, in combination:

a display,
a plurality of decision making means,
wagering means,
a processor including random means operatively coupled to said display,
said decision making means and said wagering means to receive and transmit
information therebetween,

said display including a plurality of symbols oriented in an RXC matrix,
said plurality of symbols changing as a function of said wagering means
and said random means to provide a first outcome,

said processor including a comparison means between said first outcome
and a payable, means to bestow an award if said first outcome is recognized on said
payable and including means to change the location of one or more symbols only if
said first outcome is not recognized by said payable and only when [such that] said one
or more symbols can move from their first outcome orientation to a different area in
said RXC matrix according to a rule set to provide a second outcome, such that said
second outcome is recognized by said comparison means to be on said payable and
said means to bestow an award is then activated.

Claim 7 (amended) - The gaming device of claim 1 wherein said symbols that
move from said first outcome orientation in said RXC matrix to produce said second
outcome recognized by said comparison means to be on said payable are located in
only one specific column of said RXC matrix.

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Claim 10 (amended) - The gaming device of claim 1 wherein said symbols move from said first outcome orientation to produce said second outcome recognized by said comparison means to be on said paytable, only when [wherein] said second outcome is recognized by said comparison means to be the highest-ranking combination on said paytable of possible combinations of said symbols of said first outcome orientation.

Claim 11 (amended) - The gaming device of claim 1 wherein said symbols move from said first outcome orientation to produce said second outcome, only when [wherein] said second outcome is recognized by said comparison means to be the lowest-ranking combination on said paytable of possible combinations of said symbols of said first outcome orientation.

Claim 15 (amended) - A method for wagering on a gaming device, including the steps of:

making a wager to enable the gaming device,
evoking chance means to trigger an initial outcome,
displaying the initial outcome,
comparing the initial outcome to a paytable,
awarding credits if the initial outcome is found on the paytable,
determining whether an outcome found on the paytable can be made by permuting the initial outcome only if the initial outcome is not on the paytable,
manipulating the initial [losing] outcome according to a rule set to produce a winning outcome only when the initial outcome is not on the paytable, and
awarding credits for the manipulated winning outcome found on the paytable.

Claim 16 (amended) - An apparatus for wagering, comprising, in combination:

- wagering means,
- means for displaying a plurality of symbols in an RXC matrix with N paylines,
- means for comparing displayed symbols to a paytable,
- means for incrementing an award due in the presence of a winning outcome, and
- means for changing the location of displayed symbols to produce a winning outcome only if the displayed symbols are not found on the paytable and only when the displayed symbols can be reoriented according to a rule set to an outcome recognized by the paytable whereupon said means to increment an award is enabled.